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Remarks

Thorough examination by the Examiner is noted and appreciated.

The claims have been further amended to further clarify Applicants invention.

No new matter has been added.

Support for the amended and new claims is found in the previously and originally presented claims, the Figures (including Figures 1, 1A, and 2) and the Specification including at.

[0035] As shown in FIG. 1A and indicated in step S4 of FIG. 2, the cathode/substrate 18 is immersed in the bath solution 20 by passing the substrate 18 through the composition suspension layer 26. As shown in FIG. 1A, the seed layer 19 on the substrate 18 contacts the composition suspension layer 26 and causes a wetting layer 26a to break off of the composition suspension layer 26 and adhere to the surface of the seed layer 19. This wetting layer 26a remains on the seed layer 19 during the subsequent electroplating process. It will be appreciated by those skilled in the art that the wetting layer 26a promotes wetting of the ECP electrolyte bath solution 20 to the seed layer 19 during the electroplating process.

Claim Rejections under 35 USC 102/103

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1. Claims 1, 2 and 9 stand rejected under 35 USC Section 102(b) as anticipated by, or in the alternative as obvious over Klaveness et al. (US PUB 2001/0022963).

In non-analogous art Klaveness et al. discloses light imaging contrast agents for use in in-vivo light imaging (see Title; Abstract). Klaveness et al. disclose nano-particles and composition for forming nano-particles that are used as image contrast enhancers in light imaging techniques of tissue (e.g., prior to surgery) (see paragraphs 0017-0019).

Examiner cites example 6 in Klaveness et al. for forming an image contrast nanoparticle suspension:

"EXAMPLE 6

[0090] Photolabelled Nanoparticulate Suspensions

[0091] Phytochrome is added to an aqueous solution of sodium dodecyl sulphate (pH >10). The resulting solution is added to a stirred solution of acetic acid containing a surfactant (selected from PVP, pluronics and tetronics) and the mixture is diafiltered to remove soluble salts, excess acid etc. from the suspension yielding a dispersion of 10-100 nm particles."

Thus, Klaveness et al. nowhere discloses the elements of Applicants invention including those elements in **bold type**:

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With respect to claims 1:

"An electrolyte bath, comprising:

an electrolyte solution suitable for metal electroplating; and

a composition comprising an organic acid and a non-ionic polymer mixed with said organic acid, said non-ionic polymer selected from the group consisting of an alkoxyated alcohol, an alkoxyated amine, and an alkylphenol alkoxyate;

"wherein said composition is disposed as a suspended layer within said electrolyte solution, said suspended layer adapted to form a wetting layer on a substrate as said substrate wafer is passed through said suspended layer, said electrolyte bath adapted to form said wetting layer on said substrate prior to an electroplating process in said electrolyte solution."

With respect to claims 9:

"An electrolyte bath, comprising:

an electrolyte solution suitable for copper electroplating; and

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a composition comprising an organic acid and a non-ionic polymer having a molecular weight of less than 1,000 mixed with said organic acid, said non-ionic polymer selected from the group consisting of an alkoxylated alcohol, alkoxylated amine, and an alkylphenol alkoxylate, said organic acid selected from the group consisting of citric acid and acetic acid;

wherein said composition is disposed as a suspended layer within said electrolyte solution, said suspended layer adapted to form a wetting layer on a substrate as said substrate is passed through said suspended layer, said electrolyte bath adapted to form said wetting layer on said substrate prior to an electroplating process in said electrolyte solution."

Examiner has provided a BASF Technical Bulletin, and has cited it below; the BASF Technical Bulletin discloses surfactants of **block co-polymers of propylene oxide and ethylene oxide**, otherwise referred to under the tradenames Pluronic™ and Tetronic™ (see page 1). The BASF Technical Bulletin discloses the structure of **Pluronic** surfactants (at Figures 2 and 3) where a backbone of a hydrophobic **block copolymer structure propylene oxide** is sandwiched between **hydrophilic ethylene oxide** groups (an

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OH group on the terminal end). The backbone of the structure may have many functional groups added to it and the molecular weight may be varied; the BASF Technical Bulletin teaches that "principally block copolymers provide defoaming/antifoaming action by forming an insoluble monolayer" (page 6) under "Functional Properties of Block Copolymers".

Applicants nowhere disclose or claim a non-ionic polymer comprising a block co-polymer, or ethylene oxide or propylene oxide.

Examiner admits that Klaveness et al. does not disclose an electrolyte bath suitable for electroplating or **"wherein said composition is disposed as a suspended layer within said electrolyte solution"**.

Yet Examiner argues that based on the teachings of Klaveness et al., Applicants invention **as a whole** would have been obvious to one of ordinary skill "because these claim limitations do not compositionally distinguish the bath from the prior art.

Examiner is simply mistaken in that:

- 1) Applicants **electrolyte bath suitable for metal**

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electroplating; does not compositionally distinguish over Klaveness who nowhere discloses or suggests an **electrolyte bath suitable for metal electroplating or an electrolyte bath adapted to form a wetting layer on a substrate prior to an electroplating process.** Examiner is confusing the broadness of the claim language and the clear meaning of Applicants claim language to one of ordinary skill in the art with an illegitimate requirement of requiring more specificity to narrow the claim. Moreover, Examiner, in addition to ignoring the plain meaning of Applicants claim elements, is citing **non analogous art (not in the same field of endeavor).**

2) Examiner insists on misreading Applicants claim as strictly a composition claim. Examiner has cited nothing in the MPEP or the case law that would allow Examiner to transform Applicants machine/manufacture claim into a composition claim, thereby ignoring Applicants structural claim elements and attempting to prevent Applicants from claiming their invention. It is noted Examiner has previously erroneously argued (Office action of 7/31/2007 that "claims 1 and 9 are composition claims because an electrolyte bath is not a mechanical, power driven structure". Examiner has cited no support for this novel interpretation of the patent law including Section 101 and is clearly in error as a review of Section 2106 of the MPEP will

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reveal:

A. Consider the Breadth of 35 U.S.C. 101 Under Controlling Law

As the Supreme Court has held, Congress chose the expansive language of 35 U.S.C. 101 so as to include **“anything under the sun that is made by man.”** *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). Accordingly, section 101 of title 35, United States Code, provides:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

This perspective has been embraced by the Federal Circuit:

The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term “any” in section 101 represents Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35. . . . Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations.

Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556.

As cast, 35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” while the first category defines “actions” (i.e., inventions that

“Finally, when evaluating the scope of a claim, every

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limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-189, 209 USPQ at 9.

"A claim is anticipated only **if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.**" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

"**First**, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a **reasonable expectation of success**. **Finally**, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

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disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Moreover, Examiners claims of inherency are without merit and Applicants demand support of such claim of inherency.

2. Claims 1-2, 5-6 and 9 stand rejected under 35 USC Section 102(b) as anticipated by, or in the alternative as obvious over Anderson (US 6,638,621).

Anderson in non-analogous art (**not in the same field of endeavor i.e., electroplating of metal**), discloses:

"A particle coated with a nonlamellar material such as a nonlamellar crystalline material, a nonlamellar amorphous material, or a nonlamellar semi-crystalline material **includes an internal matrix core having at least one a nanostructured liquid phase**, or at least on nanostructured liquid crystalline phase or a combination of the two is used for the delivery of active agents such as pharmaceuticals, nutrients, pesticides, etc. The coated particle can be fabricated by a variety of different techniques where the exterior coating is a nonlamellar material such as a nonlamellar crystalline material, a nonlamellar amorphous material, or a nonlamellar semi-crystalline material." (See Abstract).

In generally discussing surfactants suitable **for forming the nanostructured liquid phase**, Anderson teaches:

Chemical criteria: A number of criteria have been tabulated and discussed in detail by Robert Laughlin for determining whether a given polar group is functional as a surfactant head

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group, where the definition of surfactant includes the formation in water of nanostructured phases even at rather low concentrations. R. Laughlin, Advances in Liquid Crystals, pp. 3-41, 1978.

"Furthermore, polybutadiene of very high MW is an elastomeric polymer at ambient temperature, and block copolymers with polybutadiene blocks are well known to yield nanostructured liquid crystals. Similarly, with the introduction of branching one can produce hydrocarbon polymers such as polypropyleneoxide (PPO) which serves as the hydrophobic block in a number of amphiphilic block copolymer surfactants of great importance, such as the Pluronic series of surfactants"

Examiner erroneously argues that the disclosure of the nonanalogous art of Anderson that "adding to a test tube as a layer of solution above the previous solution" (in the formation of the coated particles and nanostructured liquid phase), is sufficient to produce the elements of Applicants claim:

"wherein said composition is disposed as a suspended layer within said electrolyte solution, said suspended layer adapted to form a wetting layer on a substrate as said substrate is passed through said suspended layer, said electrolyte bath adapted to form said wetting layer on said substrate prior to an electroplating process."

Applicants do not claim "a layer of solution above the previous solution in a test tube" as Examiner asserts Anderson discloses; but rather Applicants claim "wherein said composition

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is disposed as a suspended layer within said electrolyte solution".

Examiner also refers to Anderson's disclosure of Pluronic F-68 which may be any of a wide variety of surfactants with various physical properties not disclose anywhere in the BASF Technical Bulletin. The BASF Technical Bulletin (provided by Examiner and specifically recited below) discloses the structure of **Pluronic** to include a hydrophobic **block copolymer structure** of **propylene oxide** sandwiched between **hydrophilic ethylene oxide** groups (an OH group on the terminal end) but does not specifically disclose the structure of Pluronic F-68. The backbone of the Pluronic structure may have many functional groups added to it and it is generally disclosed that the molecular weight may be varied; the BASF Technical Bulletin teaches that "principally block copolymers provide defoaming/antifoaming action by forming an insoluble monolayer" (page 6) under "Functional Properties of Block Copolymers".

Applicants nowhere disclose or claim a non-ionic polymer comprising a block co-polymer, or ethylene oxide or propylene oxide.

Moreover, The BASF Technical Bulletin **nowhere discloses a**

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Pluronic surfactant having a molecular weight of less than 1000
(e.g., see page 28 under Properties of Pluronic R-lowest molecular weight is 1800- also note that the BASF Technical Bulletin teaches that Tetronics have a lower molecular weight than Pluronics.

Examiner again admits that Anderson does not disclose:

- 1) "an electrolyte solution suitable for metal electroplating;" thus admits Anderson is non-analogous art; and,
- 2) "wherein said composition is disposed as a suspended layer within said electrolyte solution, said suspended layer of sufficient dimension to form a wetting layer on a substrate as said substrate is passed through said suspended layer."

Examiner again refuses to acknowledge the structural elements of Applicants claim pertaining to a machine or manufacture (apparatus):

Yet Examiner merely argues that based on the teachings of Andersons, Applicants invention **as a whole** would have been obvious to one of ordinary skill "because these claim limitations do not compositionally distinguish the bath from the prior art.

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Examiner is simply mistaken in that:

1) Applicants **electrolyte bath suitable for metal electroplating (or an electrolyte bath adapted to form a wetting layer on a substrate prior to an electroplating process)**; does not compositionally distinguish over Anderson who nowhere discloses or suggests an **electrolyte bath suitable for metal electroplating or an electrolyte bath adapted to form a wetting layer on a substrate prior to an electroplating process**.

Examiner is confusing the broadness of the claim language and the clear meaning of Applicants claim language to one of ordinary skill in the art with an illegitimate requirement of requiring additional compositional specificity to narrow the claim while ignoring Applicants structural elements. Moreover, Examiner, in addition to ignoring the plain meaning of Applicants claim elements, is citing **non analogous art (not in the same field of endeavor)**.

2) Examiner insists on misreading Applicants claim as strictly a composition claim. Examiner has cited nothing in the MPEP or the case law that would allow Examiner to transform Applicants machine/manufacture claim into a composition claim, thereby ignoring Applicants claim elements and attempting to

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prevent Applicants from claiming their invention.

See e.g., MPEP 2106:

A. Consider the Breadth of 35 U.S.C. 101 Under Controlling Law

As the Supreme Court has held, Congress chose the expansive language of 35 U.S.C. 101 so as to include **"anything under the sun that is made by man."** *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). Accordingly, section 101 of title 35, United States Code, provides:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

"Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-189, 209 USPQ at 9.

Moreover, Examiners claims of inherency are without merit and Applicants demand support of such claim of inherency.

"A claim is anticipated only **if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.**" *Verdegaal Bros. v.*

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Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

3. Claims 1-2, 5-6, and 9 stand rejected under 35 USC Section 102(b) as anticipated by, or in the alternative as obvious over *Meine et al.* (US 6,689,223).

Meine et al., in non-analogous art (not in the same field of

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endeavor i.e., electroplating of metal), discloses:

"A method of cleaning hard surfaces by contact with an aqueous, liquid, multiphase, surfactant-containing cleaning composition having at least two continuous phases, one lower aqueous phase I and an upper aqueous phase II immiscible with the lower phase I, which can be temporarily converted into an emulsion by shaking and which cleaning composition contains no more than 50% by weight of nonionic surfactants, based on the total quantity of surfactants present." (see Abstract)

Examiner erroneously asserts that the disclosure of Meine et al. in connection with **a cleaning composition** that has no more than 50% by weight of nonionic surfactants based on the total quantity of surfactants including C12-C14 fatty alcohol + 1PO (propylene oxide)+1EO (ethylene oxide) ether or C10-C14 fatty alcohol +9EO butyl ether (see col 2, lines 16-30) discloses the elements of Applicants claim:

"a non-ionic polymer mixed with said organic acid, said non-ionic polymer selected from the group consisting of an alkoxylated alcohol, an alkoxylated amine, and an alkylphenol alkoxylate;"

Examiner has not established that the modified fatty alcohols (including ethylene and propylene oxide) of Meine et al. is equivalent to any one of Applicants non-ionic polymers, but even assuming *arguendo*, such is the case, such a fact does not

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help Examiner in attempting to modify **non-analogous** art to achieve Applicant invention while ignoring the structural elements of Applicants claims.

Examiner admits that Meine et al. does not disclose:

- 1) "an electrolyte solution suitable for metal electroplating;" thus admits Anderson is non-analogous art; and,
- 2) "wherein said composition is disposed as a suspended layer within said electrolyte solution, said suspended layer of sufficient dimension to form a wetting layer on a substrate as said substrate is passed through said suspended layer."

Examiner again refuses to acknowledge the elements of Applicants claim:

Yet Examiner merely argues that based on the teachings of Meine et al., Applicants invention **as a whole** would have been obvious to one of ordinary skill "because these claim limitations do not compositionally distinguish the bath from the prior art.

Examiner is simply mistaken in that:

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1) Applicants **electrolyte bath suitable for metal electroplating** does not compositionally distinguish over Meine et al. who nowhere discloses or suggests an **electrolyte bath suitable for metal electroplating or an electrolyte bath adapted to form a wetting layer on a substrate prior to an electroplating process**. Examiner is confusing the broadness of the claim language and the clear meaning of Applicants claim language to one of ordinary skill in the art with an illegitimate requirement of requiring additional compositional specificity to narrow the claim while ignoring Applicants structural elements. Moreover, Examiner, in addition to ignoring the plain meaning of Applicants claim elements, is citing **non analogous art (not in the same field of endeavor)**.

2) Examiner insists on misreading Applicants claim as strictly a composition claim. Examiner has cited nothing in the MPEP or the case law that would allow Examiner to transform Applicants machine/manufacture claim into a composition claim, thereby ignoring Applicants structural claim elements and attempting to prevent Applicants from claiming their invention.

See e.g., MPEP 2106:

A. Consider the Breadth of 35 U.S.C. 101 Under Controlling Law
As the Supreme Court has held, Congress chose the

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expansive language of 35 U.S.C. 101 so as to include
"anything under the sun that is made by man." *Diamond*
v. Chakrabarty, 447 U.S. 303, 308-09, 206
USPQ 193, 197 (1980). Accordingly, section 101 of
title 35, United States Code, provides:
Whoever invents or discovers any new and useful process,
machine, manufacture, or composition of matter, or any
new and useful improvement thereof, may obtain a patent
therefor, subject to the conditions and requirements of this
title.

"Finally, when evaluating the scope of a claim, every
limitation in the claim must be considered. Office personnel may
not dissect a claimed invention into discrete elements and then
evaluate the elements in isolation. Instead, the claim as a whole
must be considered." See, e.g., *Diamond v. Diehr*, 450 U.S. at
188-189, 209 USPQ at 9.

"A claim is anticipated only if each and every element as
set forth in the claim is found, either expressly or inherently
described, in a single prior art reference." *Verdegaal Bros. v.*
Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051,
1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail
as is contained in the ... claim." *Richardson v. Suzuki Motor*
Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

"First, there must be some suggestion or motivation, either
in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a **reasonable expectation of success**. **Finally**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim Rejections under 35 USC 103

4. Claims 4, 7 and 21-22 stand rejected under 35 USC 103(a) as being unpatentable of Klaveness et al. (US PUB 2001/0022963).

Applicants reiterate the comments made concerning the non-analogous art of Klaveness et al. above in disclosing solutions for formulating nanoparticles used for light imaging phase contrast in tissue (in-vivo).

Even assuming *arguendo* a proper motivation for modifying the solution of Klaveness et al. in forming image contrast nanoparticles, such modification does help Examiner in producing

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Applicants invention.

Examiners argument that varying the concentration of the nonanalogous art composition of Klaveness et al. in forming image contrast nanoparticles, in an effort to produce Applicants invention, is a result effective variable, is likewise misplaced since Klaveness et al. **does not disclose or suggest Applicants electrolyte bath or "an electrolyte solution suitable for metal electroplating" or an electrolyte bath adapted to form a wetting layer on a substrate prior to an electroplating process.**

"A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

"**First**, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a **reasonable expectation of success**. **Finally**, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the

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claimed combination and the reasonable expectation of success **must both be found in the prior art, and not based on applicant's disclosure.**" *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

4. Claims 5 and 6 stand rejected under 35 USC 103(a) as being unpatentable of Klaveness et al. (US PUB 2001/0022963) in further view of BASF (Surfactants: Pluronic & Tetronic)

Applicants reiterate the comments made with respect to the **non-analogous art** of Klaveness et al., above in disclosing solutions for formulating nanoparticles used for light imaging phase contrast in tissue (in-vivo).

Examiner has provided a BASF Technical Bulletin, and has cited it below; The BASF Technical Bulletin (provided by Examiner and specifically recited below) discloses the structure of **Pluronic** to include a hydrophobic **block copolymer structure** of **propylene oxide** sandwiched between **hydrophilic ethylene oxide** groups (an OH group on the terminal end) but does not specifically disclose the structure of Pluronic F-68. The backbone of the Pluronic structure may have many functional groups added to it and it is generally disclosed that the molecular weight may be varied; the BASF Technical Bulletin

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teaches that "principally block copolymers provide defoaming/antifoaming action by forming an insoluble monolayer" (page 6) under "Functional Properties of Block Copolymers".

Applicants nowhere disclose or claim a non-ionic polymer comprising a block co-polymer, or ethylene oxide or propylene oxide.

Moreover, The BASF Technical Bulletin **nowhere discloses a Pluronic surfactant having a molecular weight of less than 1000** (e.g., see page 28 under Properties of Pluronic R-lowest molecular weight is 1800- also note that the BASF Technical Bulletin teaches that Tetronics have a lower molecular weight than Pluronics.

Applicants nowhere disclose or claim a non-ionic polymer comprising a block co-polymer and BASF nowhere disclose or suggest the use of a surfactant in an electrolyte bath as Applicants have disclosed and claimed.

Even assuming *arguendo* a proper motivation for modifying Klaveness et al. based on the teachings of the BASF technical Bulletin, such modification of Klaveness et al. does not help Examiner in producing Applicants invention.

Examiners argument that varying the molecular weight of the

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composition of Klaveness et al. in forming image contrast nanoparticles in an effort to achieve Applicants invention is a result effective variable is likewise misplaced since Klaveness et al. does not disclose or suggest Applicants electrolyte bath or "an electrolyte solution suitable for metal electroplating".

"A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

5. Claims 12-13 and 23-24 stand rejected under 35 USC 103(a) as being unpatentable of Klaveness et al.

Applicants reiterate the comments made above with respect to the non-analogous art of Klaveness et al. in disclosing solutions for formulating nanoparticles used for light imaging phase contrast in tissue (in-vivo).

6. Claims 4, 7 and 21-22 stand rejected under 35 USC 103(a) as being unpatentable of Anderson et al., above.

Applicants reiterate the comments made concerning the non-

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analogous art of Anderson, above in disclosing solutions for producing coated nanoparticles used for delivery of active agents such as pharmaceuticals, nutrients, pesticides etc.

Even assuming *arguendo* a proper motivation for modifying the coated nano-particle forming solution of Anderson, such modification does not produce Applicants invention.

Examiners argument that varying the various concentrations of the composition of Anderson, in forming active agent delivery coated nanoparticles in an effort to achieve Applicants invention, is a result effective variable, is likewise misplaced since **Anderson does not disclose or suggest Applicants electrolyte bath or "an electrolyte solution suitable for metal electroplating" or an electrolyte bath adapted to form a wetting layer on a substrate prior to an electroplating process.**

"A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

"First, there must be some **suggestion or motivation,** either

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in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a **reasonable expectation of success**. **Finally**, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be found in the prior art, and not based on applicant's disclosure.** *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

7. Claims 12-13 and 23-24 stand rejected under 35 USC 103(a) as being unpatentable over Anderson, above.

Applicants reiterate the comments made concerning the non-analogous art of Anderson, above in disclosing solutions for producing coated nanoparticles used for delivery of active agents such as pharmaceuticals, nutrients, pesticides etc.

8. Claims 4, 7 and 21-22 stand rejected under 35 USC 103(a) as being unpatentable of Meine et al., above.

Applicants reiterate the comments made concerning the non-analogous art of Meine et al., above in disclosing a cleaning

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composition having at least two continuous phases, one lower aqueous phase I and an upper aqueous phase II immiscible with the lower phase I, which can be temporarily converted into an emulsion by shaking.

Even assuming *arguendo* a proper motivation for modifying the cleaning composition of Meine et al., such modification does not produce Applicants invention.

Examiners argument that varying the various concentrations of the cleaning composition of Meine, in forming one lower aqueous phase I and an upper aqueous phase II immiscible with the lower phase I, in an effort to achieve Applicants invention are result effective variables is likewise misplaced since Meine **does not disclose or suggest Applicants electrolyte bath or "an electrolyte solution suitable for metal electroplating" or an electrolyte bath adapted to form a wetting layer on a substrate prior to an electroplating process..**

"A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6

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(CCPA 1977).

"**First**, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a **reasonable expectation of success**. **Finally**, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be found in the prior art, and not based on applicant's disclosure.**" *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

9. Claims 12-13 and 23-24 stand rejected under 35 USC 103(a) as being unpatentable over *Meine et al.*, above.

Applicants reiterate the comments made concerning the non-analogous art of *Meine et al.*, above in disclosing a cleaning composition having at least two continuous phases, one lower aqueous phase I and an upper aqueous phase II immiscible with the lower phase I, which can be temporarily converted into an emulsion by shaking.

Conclusion

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The multiplicity of cited non-analogous art, singly or in combination fail to produce or suggest Applicants invention, and therefore fail to make out a *prima facie* case of anticipation or obviousness.

Applicants have further amended their claims to further define over the prior art.

Applicants appreciatively acknowledge the indication of allowable subject matter in claims 17-20 and 25-27. These claims have not been amended to achieve allowable subject matter as indicated.

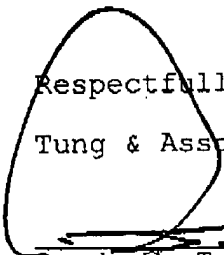
Applicants respectfully request favorable consideration of their claims and submit that Applicants Claims are now in condition for allowance. Such favorable action by the Examiner at an early date is respectfully solicited.

In the event that the present invention as claimed is not in a condition for allowance for any other reasons, the Examiner is respectfully invited to call the Applicants' representative at his Bloomfield Hills, Michigan office at (248) 540-4040 such that necessary action may be taken to place the application in a condition for allowance.

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Respectfully submitted,

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